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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/558,157	11/23/2005	Masamichi Naito	1155-0287PUS1	1891
2292 7590 11/30/2007 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			EXAMINER MULLIS, JEFFREY C	
			ART UNIT 1796	PAPER NUMBER
			NOTIFICATION DATE 11/30/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary

Application No.

10/558,157

Applicant(s)

NAITO ET AL.

Examiner

Jeffrey C. Mullis

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>2-23-06</u> | 6) <input type="checkbox"/> Other: _____ |

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Akagawa et al. (US 5,883,174).

Patentees disclose a composition containing a crystalline block copolymer "A" and a crystalline block copolymer "B" and talc (abstract). Ethylene alpha olefin copolymer as in applicants' "C" may be added at column 3, lines 6-8 and also note the examples beginning in column 14 disclosing use of EP copolymer with specific viscosity and also note use of styrenic block copolymer with MFR as in applicants "C". While the MFR of the EP copolymer is not disclosed, a specific range or narrow range of MFR would be inherent in the EP copolymer of the examples given that a single viscosity is disclosed. Given the broad range of part "C" of the claims and similar uses of applicants and patentees product it would reasonably appear that patentees EP polymer inherently has a MFR as in part "C" of the claims. The block copolymers may have 7-17% cold xylene solubles (column 20, lines 30-35) while the amount of cold xylene soluble is implied to be equal in each block copolymer is desired (see equation at column 2, line 65). While the soluble are measured in xylene, not decane, the block copolymers are hydrocarbons as is both decane and xylene and similar solubilities would reasonably be expected for both solvents. The intrinsic viscosity of "A" is above 7 while that of "B" is below 4 at column 2, lines 54-60 and hence patentees "A" corresponds to applicants "B"

and visa versa. Note for instance Example 9 in Table 7 in column 17 where the ratio of the amount of A/B is within the metes and bounds of applicants "B/A" and in which applicants amounts of talc and EP polymer are also present.. Comparative examples 22, 24 and 28 also reasonably appear to meet the limitations of the claims. The mixture of copolymer "A" and "B" have an MFR of 25-35 at column 8, lines 22-25 which would imply that teach block copolymer has such MFR but in any case note the Tables at column 14, lines 20-50 explicitly reciting applicants MFR and isotacticity for each block copolymer. While the weight fraction of xylene soluble fraction of the block copolymers used in the examples of the patent is lower than the decalin solubles of the claims, the block copolymer of the patent and claims is aliphatic and would therefore reasonably appear to be slightly more soluble in decalin. In any case choice of the higher level of solubles disclosed for the block copolymers by patentees specification would have been obvious to a practitioner having an ordinary skill in the art at the time of the invention in the expectation of adequate results absent practitioner of surprising or unexpected results. Assuming that the Office is also incorrect re applicants MFR of "C" of the instant claims, to arrive at applicants MFR would have been obvious to a practitioner having an ordinary skill in the art at the time of the invention in that it requires only routine experimentation to find the optimum or workable range of a result effective variable absent any showing of surprising or unexpected results. Furthermore, materials of identical or similar viscosity were known in the art at the time of the invention to mix more effectively and to match the viscosity of the EP rubber of patentees with the block copolymer would have been obvious to a practitioner having an ordinary skill in the art

at the time of the invention to increase ease of blending absent any showing of surprising or unexpected results.

When the reference discloses all the limitations of a claim except a property or function, and the Examiner cannot determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention, basis exists for shifting the burden of proof to applicant. Note In re Fitzgerald et al. 619 F. 2d 67, 70, 205 USPQ 594, 596, (CCPA 1980). See MPEP § 2112-2112.02.

Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi et al. (US 5,880,198).

Patentees disclose a composition which may contain two propylene polymers of different MFR's and a styrenic block copolymer (abstract). The first block copolymer may be present at a level of 10-50% as may the second block copolymer (paragraphs bridging columns 9 and 10 as well as 10 and 11). The styrenic block copolymer used in the examples have applicants MFR in part "C" of the instant claims (Table 2 in column 14). The intrinsic viscosities of the two propylene block copolymers is 2-7 and the isotactic pentad content is 2-7 in patent claim 1. With re to applicants specific amounts of "A" and "B", these can be arrived at by selecting within the amounts of 10-50%

disclosed for each propylene block copolymer and applicants intrinsic viscosities for each are within the range disclosed by the patent. Hence to arrive at applicants specific combination of features by selecting from the various disclosures of the patent would have been obvious to a practitioner having an ordinary skill in the art at the time of the invention in the expectation of adequate results.

Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Akagawa et al. (US 5,837,764).

Patentees disclose a composition containing 2ethylene-propylene block copolymers having a xylene content of differing viscosities overlapping with applicants decalin viscosity of "A" and "B" of the instant claims and which may have applicants specific content of the first block copolymer as well as the second and which contains talc and ethylene alpha olefin copolymer of specific MFI. Note the abstract and claims 4 and 7. Although the MFI of the ethylene alpha olefin copolymer is measured at 190 degrees and is .5-3 (column 10, lines 40-60), the MFR would be higher when measured at 230 degrees and therefore reasonably appears to encompass applicants MFR. While there are no examples with applicants' combination of features (Example 9 in Table 4 appears to be very close but component "A" is present in slightly higher amounts than the claims allow for), to arrive at applicants specific combination of features by selecting from the various disclosures of the patent would have been obvious to a practitioner having an ordinary skill in the art at the time of the invention in the expectation of adequate results.

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Komatsu et al. (US 4,960,823), cited of interest, discloses a composition similar or identical to applicants except that there is no teaching or suggestion of applicants amounts of applicants "C" and "D" components.

Any inquiry concerning this communication should be directed to Jeffrey C. Mullis at telephone number 571 272 1075.

Jeffrey C. Mullis
Primary Examiner
Art Unit 1796

JCM

11-20-07

A handwritten signature in black ink, appearing to be 'JCM', located below the printed name of the examiner.